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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/941,605 09/30/97 WOOD

E ITI-138C

EXAMINER

IM62/0821

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NOLAN, S

ART UNIT

PAPER NUMBER

1772

20

DATE MAILED:

08/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/941,605

Applicant(s)

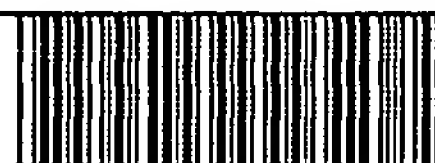
Wood

Examiner

Sandra Nolan

Group Art Unit

1772



☒ Responsive to communication(s) filed on Jun 19, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 9 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 9 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

#### **CONTINUED EXAMINATION UNDER 37 CFR 1.114 AFTER FINAL REJECTION**

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee has been paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment and arguments filed on June 19, 2000 (Paper No.19) have been entered.

#### **ENTRY OF AMENDMENT SUBMITTED BEFORE THE REQUEST FOR RCE**

2. The amendment submitted on December 17, 1999 (Paper No.16) has been entered. Accordingly, claim 9 is pending.

### **NEW REJECTION**

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The examiner is unable to find support for the phrases (a) "formed from two sections" and (b) "bonded at the intersection of the plane of the collar and the tubular section" in the original application. Accordingly, the claim is rejected for containing new matter.

**REJECTION MAINTAINED**

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The 35 USC 103 rejection of claim 9 as unpatentable over Long et al (US 5108533), as stated in paragraphs 4 through 7 of the Office Action mailed on December 10, 1998 (Paper No. 9), is maintained for the reasons made of record therein.

**RESPONSE TO ARGUMENTS**

7. Applicant's arguments filed in Paper No. 19 have been fully considered but they are not persuasive.

The amendment to claim 9 introduced material that was not found in the original application and is, therefore, deemed new matter. This material may not be relied upon to distinguish the claim from the teachings of the Long et al patent.

At pages 2-4 of Paper No. 19, Applicant summarizes his invention.

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At page 4 of that paper, Applicant mentioned "the claimed shapeless and fully conformable collar". The Examiner notes that the Figure 7, which is referred to on page 3 of the response is not "shapeless".

Also, the terms "shapeless" and "conformable" are not recited in the claims. Note, however, that the Examiner is not aware that Applicant has basis in the specification for such terms and is not suggesting that they should be added to the claim.

The response goes on to explain, at page 5, that Applicant's article is inserted from a lateral line of the piping system in to a main line thereof, while Long et al's is inserted from the main line into a lateral line. As has been mentioned previously, the manner in which the article claimed is used does not have any bearing on its patentability because it is being claimed as an article. Its chemical/structural features must distinguish it from the prior art, not its intended use.

At page 6, Applicant emphasizes that his article is formed of two elements and that this is in contrast to the Long et al teachings.

The Examiner disagrees. First of all, Long et al teaches the use of two pieces to make their liner. See col. 5, lines 14+ and col. 6 lines 46+.

Secondly, the new limitation re: two sections is the basis of a new matter rejection hereinabove. It cannot be properly relied upon to distinguish the claim from Long et al.

The argument that Applicant uses two similar materials while Long et al use two different ones, at page 7 of the response, is not convincing. In order to be of use, the article claimed by Applicant must be bonded to one or more surfaces within the main pipe and/or the lateral. Thus,

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an adhesive of some kind--which adhesive is not recited in Applicant's claim--must be used with the liner in order for it to function in repairing the pipe(s) concerned. Thus, the difference argued does not exist, because both Applicant and Long et al apply adhesive before they use their liners.

The argument--on page 8 of the response--that there is no affirmatively stated rejection of claim 9 of record is not persuasive. Claim 9 was rejected under 35 USC 103 as unpatentable over Long et al in paragraph 5 of the June 14, 1999 Office Action (Paper No. 13). Note that paragraph 6 of that Office Action stated that claim 9 was included pursuant to Applicant's amendment of March 31, 1999 (Paper No. 11).

Lastly, Applicant asserts that there is no suggestion within Long et al to provide for two separate elements which are bonded together at the intersection of the plans so that there is a tubular element for insertion into the lateral bonded to a collar of the same material which is adapted to seat within the main pipeline at the lateral connection". While unclear as to what the quoted passage is supposed to mean, the Examiner maintains that:

A) Figure 1 of this application and Figure 10 of Long et al illustrate comparable insertion processes;

B) the flexible retainer 46 attached to Long et al's tube 41 is suggestive of Applicant's collar, which is attached to Applicant's tube (see col. 6, lines 27+ of Long et al);

C) Long et al's "annular" retainer is suggestive of the "collar" recited by Applicant (see col. 6, lines 34-39); and

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D) Long et al's retainer **46** is flexible so that it can be compressed or compacted radially inwardly into position within the pipe during insertion (see col. 7, lines 4-11).

In sum, the Long et al patent suggests the claimed invention as a whole and the 35 USC 103 rejection is proper.

**FINAL REJECTION**

8. Claim 9 is drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office Action if the it had ben entered in the application prior to entry under 376 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP section 706.07(b). Applicant is reminded of the extension of time policy set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

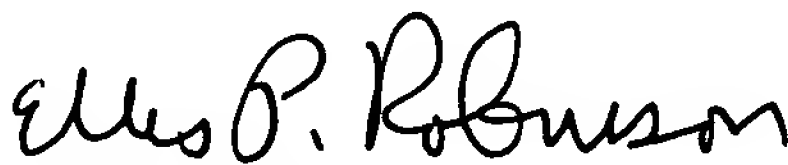
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CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra M. Nolan, whose telephone number is (703) 308-9545. The examiner can normally be reached on Monday through Thursday from 7:00 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ellis P. Robinson, can be reached on (703) 308-2364. The fax phone number for the organization where this application is assigned is (703) 305-5408.

The telephone number for the receptionist is (703) 308-0661.

  
Ellis Robinson  
Supervisory Patent Examiner  
Technology Center 1700

SMN/smn  
August 14, 2000  
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